

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claim 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,540,433 to Brockman (hereinafter “Brockman”) in view of FR 2,492,648 to Greutert (hereinafter “Greutert”). Additionally, the Examiner rejects claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Brockman and Greutert and further in view of U.S. Patent No. 4,445,525 to Slover et al., (hereinafter “Slover”). Lastly, the Examiner rejects claims 29 and 31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,632,175 to Marshall (hereinafter “Marshall”) in view of Brockman.

In response, Applicants respectfully traverse the Examiner’s rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, independent claims 2 and 29 have been amended to clarify their distinguishing features.

The Examiner now combines Brockman with a reference showing a metallic mesh or net filter (citing reference character 1 in Figures 1-4). Based on an English Abstract of Greutert, it appears that the same is directed to a metal filter for a coffee machine that **holds and contains** coffee grinds.

Thus, the Examiner argues that the combination of Brockman and Greutert disclose all of the features of claim 2.

**Firstly, the Applicants respectfully submit that the combination of the Brockman and Greutert references is improper and must be withdrawn.**

With regard to the combination, Applicants respectfully submit that there is no motivation to combine such references nor would those skilled in the art feel that the combination is predictable. Firstly, the Examiner argues that the motivation for combining the

filter of Greutert with Brockman is to provide a reusable net. Applicants submit that many materials can be chosen that would provide a reusable net, such as plastic or non-magnetic metals, such as stainless steel, which is typically used in medical applications. Therefore, those skilled in the art, even if motivated by the need for a reusable material, would not look to the coffee filter of Greutert but would more likely look to non-magnetic materials that are typically used in medical devices (i.e., for reasons of cleaning and sterilization). Secondly, Greutert is directed to something that **holds and contains** a material (coffee grinds) and is not used to catch a moving object.

Thus, for at least the reasons set forth above, the Applicants respectfully submit that the rejection of claim 2 for obviousness under 35 U.S.C. 103(a) is improper and must be withdrawn.

**Secondly, Applicants respectfully submit that at least the Greutert reference is from a non-analogous art and is an improper reference to be applied against claim 2.**

To be considered analogous art, the references cited by the Examiner must be either in the same field as the invention or be reasonably pertinent to the problem faced by the inventor.<sup>1</sup> Applicants respectfully submit that neither of these requirements have been met in the present case.

With regard to the first prong of the non-analogous art test, namely, whether a reference is within the field of the invention, the Federal Circuit has stated:

We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances” -in other

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<sup>1</sup> See, e.g., *In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992); *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); and *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ 2d 1767 (Fed. Cir. 1993).

words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.<sup>2</sup>

Thus, a case-by-case analysis must be made to determine if a person of ordinary skill would look to the fields of the references for a solution to the problem facing the inventor.<sup>3</sup>

In clarifying how to determine the second prong of the test -- namely, whether a reference is reasonably pertinent to the particular problem with which an inventor was involved, the Federal Circuit has stated that:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.<sup>4</sup>

In this regard, Applicants submit that Greutert is neither directed to the same field of endeavor nor directed to solving the same problems as the invention recited in claim 2. Greutert is directed to the non-analogous field of coffee machines and as discussed above, is not concerned with the objective of catching a moving object but for holding and containing coffee grinds as a fluid moves through it.

To paraphrase the words of the Federal Circuit, the matter with which the Greutert reference deals logically would not have commended itself to the inventors' attention

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<sup>2</sup>       *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

<sup>3</sup>       Id. See also, *In re Wright*, 848 F.2d 1216, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) ("[A]s with all section 103 decisions, judgment must be brought to bear based on the facts of each case.").

<sup>4</sup>       *In re Clay*, 23 USPQ 2d at 1060-1061.

in considering his problem. Thus, since it is directed to different purposes, the inventors would accordingly have had no motivation or occasion to consider it.

Accordingly, Applicants respectfully submit that the Greutert reference is not in the same field of endeavor as the present invention, nor is it reasonably pertinent to the particular problem with which the inventors of the present invention were involved. Consequently, the Examiner is respectfully requested to withdraw the Greutert reference, thereby rendering the 35 U.S.C. 103(a) rejection of claim 2 moot.

However, claim 2 has been amended to clarify that “the catch unit is a net for retrieving or catching the medical capsule and at least a part of the net for retrieving or catching the medical capsule is made of a magnet or a magnetic material.”

Applicants submit that claim 10 is allowable for at least the same reasons as set forth above with regard to claim 2. Applicants further submit that claim 10 is at least allowable as depending from an allowable base claim (2).

With regard to claim 29, the Examiner reiterates the combination of Marshall with Brockman since Brockman teaches retrieving and catching internal parasites. Applicants respectfully disagree. Although Brockman may be said to disclose catching the parasites, it cannot be said to retrieve the parasites. Retrieval means (consistent with the description of the specification as the same would be understood by those of ordinary skill in the art) that you once had the object and are now getting it back (retrieving). Thus, the capsule is introduced and retrieved, the parasites are never introduced but naturally occurring, therefore, they are caught for the first time in the device of Brockman.

Such an argument was previously made in response to the previous Official Action without amendment to claim 29. However, in the interests of advancing prosecution, claim 29 has now been amended to expressly recite that which was previously inherent therein and to clarify the above distinction. Namely, claim 29 has been amended to change “a step of catching...” to --a step of retrieving...--. As discussed above, Applicants respectfully submit that the above definition of “retrieving” is supported in the specification and would be understood as such to those of ordinary skill in the art. Claim 29 has also been amended to further clarify that the retrieving using a catch unit is “for magnetically attracting one of a magnetic material and a magnet in the medical capsule.”

Accordingly, claim 29 patentably distinguishes over the prior art and is allowable. Claim 31, being dependent upon claim 29, is thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 29 and 31 under 35 U.S.C. § 103(a).

The amendments to claims 2 and 29 are fully supported in the specification and have been raised in previous communications. Thus, such amendments neither enter new matter into the original disclosure nor raise new issues. Therefore, Applicants respectfully request that the present amendments to claims 2 and 29 be entered and considered by the Examiner.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case,  
the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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